

Appl. No. 10/023,245
Appeal Brief dated February 1, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/023,245 Confirmation No.: 3893
Applicant(s): Kevin F. Bernier et al.
Filed : December 18, 2001
Title : METHOD AND SYSTEM FOR GENERATING
A PERMANENT RECORD OF A SERVICE
AT A REMOTE PRINTER
TC/A.U. : 2153
Examiner : Yasin M. Bargadle

Docket No. : 8522
Customer No.: 20349

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APPEAL BRIEF

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Sir:

This is appellants' Appeal Brief in the appeal taken from the final rejection of claims 1 - 24 of the application as set forth in the Office Action, made final, mailed June 30, 2005. A two (2) month extension of the time period to file the Appeal Brief has been obtained by a Petition filed on even date herewith.

REAL PARTY IN INTEREST

The real party in interest in this appeal is Polaroid Corporation, a corporation organized and existing under the laws of the State of Delaware, of 1265 Main Street, Waltham, MA 02451.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF CLAIMS

1. Claims 1 - 24 have been rejected as being unpatentable.
2. Claims 25 - 30 have been withdrawn from consideration pursuant to a requirement for Restriction.

STATUS OF AMENDMENTS

Appellants did not file an amendment after the final Office action and elect to prosecute this appeal on the basis of the claims which were in the application prior to the final Office Action.

SUMMARY OF INVENTION

Appellants' claims are directed to situations where a user contacts a service provider, such as an airline, digital photo processor, rebate coupon service etc., via a mobile computing and/or communication device (which does not include an attached or integrated printer) to initiate and complete a service transaction with a remote service provider and would like to obtain a permanent record of the transaction at a remote printer chosen and designated by the user. This provides the user with a much more convenient alternative to doing these types of transactions at a fixed location computer that has an attached or integrated local printer.

To carry out the purpose of having the remote service provider deliver the input data for the permanent record to the user chosen and designated remote printer, as set forth in the claims, the user must provide the service provider with the data necessary to provide the service including user provided data identifying and specifying the user chosen remote

printer and data regarding how to address and access the remote printer over a data communications network.

Thus, when using the methods and systems embodying the present invention, it is the user who is allowed to select a convenient location of the printer to which the permanent record will be printed rather than having the service provider printing it on a remote printer of its choosing and designation after which the printed record would have to be shipped or delivered to the user.

REFERENCES APPLIED BY EXAMINER

1. United States Patent Application Publication No. US 2002/0078160 A1 ("Kemp et al.").
2. United States Patent Application Publication No. US 2002/0100802 A1 ("Sehr").

DISCUSSION OF THE REFERENCES

1. Kemp et al. is directed to a remote printing service provided by a company such as Kinko's®. A user sends a file to the company over a data network, such as the Internet, to be printed on the service provider printers at its print shop -- see Service Provider (Print Shop) in Figs. 1 and 3 including local Kinko's® printers 21, 23, 24, 25 and 26 and paragraph [0056]. The service provider initially confirms that it can perform the requested print job and then communicates over the communications network with the customer to obtain the customer's agreement with the

terms of the transaction, e.g., the cost. The service provider then prints the customer's job on the service provider's printers. The printed items are to be shipped or delivered to the user, or the user stops by to pick up these items.

2. Sehr is directed to a system and method utilizing passport documents and is aimed at the travel industry. The user applies for and is issued a computerized data card (SmartCard) which is recognized by one or multiple service providers including airlines, banks, stores, etc. The user interfaces with the Sehr system by inserting his/her card into a variety of card reading machines operated by the service provider. In certain embodiments the service provider machines include a printer which allows the user standing in front of the machine to print out hard copies of tickets, travel statements and expense reports. The printer and its location are controlled by the service provider. There is no option for the user to have a document printed out at a remote printer that is more convenient for the user.

ISSUES

A. Whether claims 1 and 15 comply with the written description requirement of the first paragraph of 35 USC § 112.

B. Whether claims 1 - 10, 13 - 18 and 21 - 24 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Kemp et al.

C. Whether the subject matter of claims 11, 12, 19 and 20 is unpatentable under 35 USC § 103(a) over Kemp et al. in view Sehr.

GROUPING OF CLAIMS

Pursuant to 37 CFR 1.192(c)(7), appellants request that the claims on appeal be considered as two separate groups as follows:

1. Claims 1 - 10, 13 - 18 and 21 - 24.
2. Claims 11, 12, 19 and 20.

ARGUMENT

I. The Section 112 Rejection

Issue (A)

Summary

The specification describes the subject matter recited in claims 1 and 15 in a manner so as to convey to those skilled in the art that appellants were in possession of that subject matter at the time the application was filed.

Detailed Argument

The rejection is based on the language "user chosen and designated" as it characterizes the remote printer in the claimed method and system of appellants. In support of this ground of rejection the Office Action states the

Examiner could not find in the specification the language of user chosen and designated

remote printer or any similar language where user chooses and designates a specific remote printer.

The Office Action appears to take the position that the specific language, or similar language, must be present in the specification in order to satisfy with the written description requirement. This is not what the disclosure has to include in order to be in compliance with the written description requirement.

It is well settled that language in a patent claim does not have to appear in the specification *in haec verba*. It is sufficient that the descriptive text show that the inventor possessed the technologic information for which claim coverage is sought and discloses the invention to the public. See *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d1320, 1323 [56 USPQ2d 1481] (Fed. Cir. 2000). The written description serves the fundamental patent purpose of making known what has been invented, including any variations and alternatives contemplated by the inventor. See *Space Systems/Loral Inc. v. Lockheed Martin Corp.*, 74 USPQ2d 1534 (Fed.Cir. 2005).

When viewed according to the proper standard the term "user chosen and designated remote printer" is clearly disclosed by the specification as a feature of appellants' claimed invention. The embodiment encompassed by the claim language is referred to in a number of places in the specification.

The Background section of the present specification discusses using a communication device such as a computer to purchase services such as tickets over a communication network such as the Internet (see the second paragraph on page 1). In the context of this discussion it is pointed out that generating a permanent record for the service(s) obtained using a computer requires issuing a print command in order to print the document at a printer connected to the computer. The specification states that

This limitation precludes obtaining the service at one site and a permanent record at another site as would be the case if the user wanted to share a permanent record of an image with another user at a remote site or if the user wanted to print the permanent record of a ticket at another site.

Clearly, this discussion is referring to a situation where the user desires to print a permanent record of a transaction at a printer at a site remote from that where the transaction was initiated and carried. There can be no dispute that the printer at the remote site would be one chosen and designated by the user.

The first sentence of the paragraph immediately following the heading "SUMMARY OF THE INVENTION" states:

It is the primary object of this invention to provide users with the ability to obtain, at a remote printer, a permanent record of a rendered service.

Taken in conjunction with the statement in the specification referred to above, it follows logically

that one skilled in the art would understand that appellants, in the statement of the primary object of the invention, are referring to a remote printer chosen and designated by the user. There can be no other reasonable interpretation; given the overall description of the invention in the specification and the statements referred to above, it is evident that the user would choose and designate the remote printer.

Fig. 1 describes an embodiment of the invention. This embodiment describes generating at remote printer 15 a permanent record of a service requested from communications device 10. This embodiment is described in relation to the flow chart of Fig. 5A.

At page 10 the specification states, in the first full paragraph:

Included in the data necessary to provide the service (120, Fig, 5A) are of (sic) means for identifying the user and a remote printer, for providing a permanent record, and the location of the printer. (emphasis added)

and further, the last sentence of that paragraph states:

Alternatively, the user can provide location and access means for a remote printer to be used for that particular request.

Thus, the description of this embodiment of the invention clearly teaches that the remote printer is chosen and designated by the user.

It has been shown that the subject matter of the claims complies with the written description requirement of 35 U.S.C. § 112. The USPTO has not

sustained the burden of showing that the claims violate the written description requirement.

II. The Art rejections

Issue (B)

Kemp et al. does not teach each and every element of the subject matter recited in claims 1 - 10, 13 - 18 and 21 - 24 as is required to support a rejection under 35 U.S.C. § 102(e).

As discussed above, appellants' invention is directed to situations where a user contacts a service provider, such as an airline, digital photo processor, rebate coupon service etc., via a mobile computing and/or communication device (which does not include an attached or integrated printer) to initiate and complete a service transaction with a remote service provider and would like to obtain a permanent record of the transaction at a remote printer chosen and designated by the user. To carry out the purpose of having the remote service provider deliver the input data for the permanent record, e.g., a ticket to an event, to the user chosen and designated remote printer, as set forth in the claims, the user must provide the service provider with the data necessary to provide the service including user provided data identifying and specifying the user chosen remote printer and data regarding how to address and access the remote printer over a data communications network.

Kemp et al. is directed to a remote printing service provided by a company such as Kinko's®. To

obtain the service a user sends a file to the service provider over a data network, such as the Internet, to be printed on the service provider printers at its print shop -- see Service Provider (Print Shop) in Figs. 1 and 3 including local printers 21, 23, 24, 25 and 26 and paragraph [0056].

The service provider initially confirms that it can perform the requested print job and then communicates over the communications network with the customer to obtain the customer's agreement with the terms of the transaction, e.g., the cost. The service provider then prints the customer's job on the service provider's printers.

After the service provider prints the customer's job, the printer items are shipped or delivered to the user, or the user stops by to pick up these items -- see paragraph [0066]. After the service provider prints the customer's job, the printed items are to be shipped or delivered to the user, or the user stops by to pick up these items.

The entire disclosure of the reference is directed to printing documents at the location of the service provider in response to a request by a customer. There is no teaching or suggestion with respect to processing on the service provider operated remote server the data required for the service and other stored data to generate input data for a specific and identified user chosen and designated remote printer. In the method of Kemp et al. the permanent record of the service requested, i.e., the printed documents, is

printed on the printers of the service provider. The printed documents would have to be shipped or delivered to the user as opposed to the method of appellants where the permanent record of the service, e.g., a ticket, is printed on the user chosen and designated remote printer.

The Office Action refers to paragraphs [0037] - [0041] and [0084] - [0087] as teaching step (B) of appellants' claim 1 (see page 6 of the Office Action). This part of the disclosure of the reference does not teach generating input data for a specific and identified user chosen and designated remote printer. Rather these paragraphs describe equipment of the service provider, such as the type of printers, to perform the requested print job(s) and describe "...process steps performed on the service provider side in processing a request for printing to a service provider over the Internet." (emphasis added). See paragraph [0084].

According to Kemp et al. the "processing" described in paragraph [0084] involves determining whether the print shop can process the print request and, if so, consults with the requester to confirm the job request. Upon confirmation by the requester the print job is completed.

There is no teaching in these paragraphs with respect to generating input data to transmit to a specific and identified user chosen and designated remote printer so as to provide at the location of the

remote printer a permanent record of the service requested.

The Office Action refers to paragraphs [0020] - [0023], [0038] - [0042], [0048] - [0053], [0069] - [0070] and [0085] - [0087] as teaching step (C) of appellants' claim 1 (see page 6 of the Office Action).

These parts of the reference do not teach step (C) of appellants' claim 1 which requires that the service provider transmit the input data over a data communication network to the specific user designated remote printer where the input data is rendered by the specific printer as the permanent record of the service.

Paragraphs [0020] - [0023] describe how the customer and service provider can communicate over the Internet concerning a job request. Paragraphs [0038] - [0042] describe equipment of the service provider, such as the type of printers, to perform the requested print job(s). Paragraphs [0048] - [0053] describe the client's computer 10 (see Fig. 2). Paragraphs [0069] - [0070] describe steps the service provider goes through prior to printing the job request and paragraphs [0085] - [0087] describe steps the service provider performs if it is determined that the service provider is capable of processing the job.

It is evident that Kemp et al. does not specifically teach critical elements of appellants' claimed subject matter. To reiterate, according to appellants' claimed method and system the service provider operated remote server generates input data for a specific and identified user chosen and designated

remote printer and then transmit the input data over a data communication network to the specific user designated remote printer where the input data is rendered by the that printer as the permanent record of said service. This is in contrast to the method of Kemp et al. where the service provider prints the permanent record of the transaction on a remote printer chosen and designated by the service provider after which the printed record would have to be shipped or delivered to the user.

Kemp et al. does not teach or suggest these critical features of appellants' invention. Therefore, the USPTO has not sustained the burden of showing that claims 1 - 10, 13 - 18 and 21 - 24 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Kemp et al.

Issue (C)

There is no suggestion or incentive to be found in the references which would place one skilled in the art in possession of the claimed subject matter as is required to properly support a rejection under Section 103.

Claims 11 and 12 recite the embodiments of appellants' method wherein the requested service is an event ticket and a coupon, respectively and claims 19 and 20 recite the corresponding system embodiments. These claims are dependent upon claims 1 and 15 respectively.

It has been shown above that Kemp et al. does not in any way suggest appellants' claimed method and system. The secondary reference, Sehr, like Kemp et al., also does not teach or suggest the subject matter of these claims within the meaning of Section 103.

Sehr is directed to a system and method utilizing passport documents and is aimed at the travel industry. The user applies for and is issued a computerized data card (SmartCard) which is recognized by one or multiple service providers including airlines, banks, stores, etc. The user interfaces with the Sehr system by inserting his card into a variety of card reading machines operated by such service provider. In certain embodiments the service provider machines include a printer which allows the user standing in front of the machine to print out hard copies of tickets, travel statements and expense reports. The printer and its location are controlled by the service provider. There is no option for the user to have a document printed out at a remote printer that is more convenient for the user.

In order to properly support a rejection of claims under 35 U.S.C. § 103 a reference, or references, must place the claimed subject matter of appellants in the possession of the public. The reference(s) must provide some teaching or suggestion which would enable those skilled in the art, in conjunction with their knowledge of the state of the art, to know of appellants' invention.

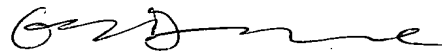
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Here, Kemp et al. and Sehr do not sustain this burden. Only appellants' disclosure provides such a teaching. Hence, the USPTO has not sustained the burden of showing that the subject matter of claims 10, 11, 19 and 20 is not patentable.

CONCLUSION

For all of the foregoing reasons the rejections of claims should be reversed and claims 1 - 24 allowed.

Respectfully submitted,



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CLAIMS APPENDIX

Claims On Appeal

1. A method of providing a service and generating, at the location of a user chosen and designated remote printer, a permanent record of said service, wherein, before generating the permanent record, data necessary to provide said service and data necessary to provide said permanent record are processed by at least one remote server operated by a service provider, said method comprising the steps of:

(A) receiving over a data communications network at a remote service provider receiving center, from a user operated communications device, a request for the service and said data necessary to provide the service including user provided data identifying and specifying said user chosen remote printer and data regarding how to address and access said remote printer over a data communications network, said receiving center comprising at least one service provider operated remote server; said data necessary to provide the service being processed to generate data required for the service;

(B) processing on said service provider operated remote server said data required for the service and other stored data to generate input data for a specific and identified user chosen and designated remote printer;

(C) transmitting by said service provider over a data communication network to said specific user

designated remote printer said input data, said input being rendered by the specific printer as the permanent record of said service.

2. The method of Claim 1 wherein the receiving center comprises a receiving server.

3. The method of Claim 2 wherein step (B) further comprises the steps of:

providing said data required for the service to a printing server; and
generating the input data for a specific printer at the printing server.

4. The method of Claim 1 wherein step (B) further comprises:

completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers.

5. The method of Claim 2 wherein step (B) further comprises:

completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers.

6. The method of Claim 1 further comprising the step of:

sending, after step (B) a message confirming that the request for service has been fulfilled.

7. The method of Claim 2 further comprising the step of:

sending, after step (B) a message confirming that the request for service has been fulfilled.

8. The method of Claim 1 wherein step (B) further comprises:

processing the data for the service and other data to generate input data to produce the optimal quality print for a specific printer.

9. The method of Claim 2 wherein the receiving server is a printing server.

10. The method of Claim 2 wherein the receiving server is a service server.

11. The method of Claim 1 wherein the requested service is an event ticket.

12. The method of Claim 1 wherein the requested service is a coupon.

13. The method of Claim 1 wherein the requested service is an image.

14. The method of Claim 1 wherein the requested service is a compound document.

15. A system for providing a service, generating, at the location of a user chosen and designated remote printer, a permanent record of said service, and, before generating the permanent record, processing, utilizing at least one remote server operated by a service provider, data necessary to provide said service and data necessary to provide said permanent record, said system comprising:

means for receiving at a remote service provider receiving center, from a user operated communications device, a request for the service and said data necessary to provide the service including user provided data identifying and specifying said user chosen and designated remote printer and data regarding how to address and access said remote printer over a data communications network, said receiving center comprising at least one service provider operated remote server; said data necessary to provide the service being processed to generate data required for the service; and,

means for processing on said service provider operated remote server said data required for the service and other stored data to generate input data for

a specific and identified user chosen and designated remote printer; and,

means for transmitting by said service provider over a data communication network to said specific user designated remote printer said input data, said input being rendered by the specific printer as the permanent record of said service.

16. The system of Claim 15 further comprising:
means for completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers.

17. The system of Claim 15 further comprising:
means for sending, after processing the data required for the service, a message confirming that the request for service has been fulfilled.

18. The system of Claim 15 further comprising:
means for processing the data for the service and other data to generate input data to produce the optimal quality print for a specific printer.

19. The system of Claim 15 wherein the requested service is an event ticket.

20. The system of Claim 15 wherein the requested service is a coupon.

21. The system of Claim 15 wherein the requested service is an image.

22. The system of Claim 15 wherein the requested service is a compound document.

23. The system of Claim 15 wherein the receiving center comprises a receiving server.

24. The system of Claim 15 further comprising:
means for providing said data required for the service to a printing server; and
means for generating the input data for a specific printer at the printing server.

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EVIDENCE APPENDIX

Appellants have not submitted in the application any evidence pursuant to §§ 1.130, 1.131 and 1.132 of 37 Code of Federal regulations.

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RELATED PROCEEDINGS APPENDIX

There are no decisions by a court or the Board of Patent Appeals and Interferences in any related proceedings.

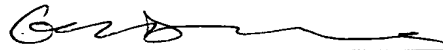
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Date: February 27, 2006



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